

REMARKS

This is being filed in response to the Official Action of February 14, 2003. Due to a blackout of the East Coast of the United States on August 14, 2003, the Notice of Appeal while prepared and ready for mailing was not mailed on that date. This response is being filed in accordance with the time limit set out in the Decision on Petition to revive the instant application under 37 CFR 1.137(a) as abandoned due to unavoidable delay dated December 22, 2003 and the provisions of 37 CFR 1.136(a). This response is accompanied by a request for continued examination.

Claims 1-7 are in this application. Claims 8-12 have been cancelled. Applicants preserve all rights to file one or more divisional applications directed to the subject matter of claims 8-12.

On page 2 of the Office Action it is stated that "claims 1-7 under 35 USC 103(a) as being obvious over Devgan and Bokadia (Aust. J. Chem., 1968, 21, 3001-3003)." Applicants respectfully traverse this.

The standard test used to establish *prima facie* obviousness is the test set out by the Supreme Court in *Graham v. John Deere* (383 US 1, 148 USPQ 459 (1966)) in view of March et. a. To determine whether a claim is *prima facie* obvious:

- 1) the scope and content of the prior art are to be determined;
- 2) the differences between the prior art and the claims at issue are to be ascertained; and
- 3) the level of ordinary skill in the pertinent art resolved.

In addition, according to MPEP 2141, citing *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n. 5 (Fed. Cir. 1986), when applying 35 USC 103, the following tenets of patent law must be adhered to:

- 1) the claimed invention must be considered as a whole;
- 2) the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; and
- 3) the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention.

Reasonable expectation of success is the standard with which obviousness is determined. *In re Merck & Co., Inc.*, 800 F.2d109, 231 USPQ 375 (Fed. Cir. 1986).

The reason, suggestion or motivation to combine references may be found explicitly or implicitly. While the references need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability must be clear and particular. *Ruiz v. A.B. Chance Co.*, 57 USPQ2d 1161 (Fed. Cir. 2000).

It is known that non-obviousness may be established by the use of "secondary considerations or objective factors." *United States v. Adams*, 383 U.S. 39, 148 USPQ 479 (1966).

In this case, the court considered certain of the secondary considerations noted in *Graham* as follows:

We conclude that the Adams battery was also nonobvious. ... despite the fact that each of the elements of the Adams battery was well known in the prior art, to combine them as did Adams required that a person reasonably skilled in the prior art must ignore (two well-known disadvantages of the approach he took). These long-accepted factors, when taken together, would, we believe, deter any investigation into such a combination used by Adams. This is not to say that one who merely finds new uses for old inventions by shutting his eyes to their prior disadvantages thereby discovers a patentable invention. We do say, however, that known disadvantages in old devices that would naturally discourage the search for new inventions may be taken into account in determining obviousness. Nor are these the only factors bearing on the question of obviousness. We have seen that at the time Adams perfected his invention, noted experts expressed disbelief in it. Several of the same experts subsequently recognized the significance of Adams invention.

Decisions of the Court of Appeals for the Federal Circuit make it clear that these so-called secondary considerations are important indicia of patentability. Indeed some decisions raise an enquiry into these factors, which they tend to refer to as "objective factors" rather than secondary ones, as a factual enquiry that is on the same level as the three factors traditionally considered under the *Graham* approach. In *Panduit Corp v. Dennison Mfg Co.* 1 USPQ2d 1593 (1987) the Federal Circuit listed such factors as including: "commercial success due to the invention; failure of others; long felt need; movement of the skilled in a different direction;

skepticism of experts; copying the invention in preference to the prior art; and other events proved to have actually happened in the real world."

In *Union Carbide Corp v. Dow Chemical*, 682 F.2d. 1136, 217 USPQ 1195 (5th Cir. 1982) the court was persuaded of the non-obviousness of an invention by a combination of the fact that the defendant had itself made repeated attempts to solve the problem in question, but had failed to do so.

The instant invention has successfully addressed a long-felt need to obtain economically viable product from the tetraploid and hexaploid strains of *Acorus calams* and other plants.

β -asarone having an identical UV and IR with γ -asarone (Devgan et al.) dissuades a person skilled in art from reaching the conclusion that hydrogenating β -asarone will cause a reduction of toxicity. Therefore, Devgan et al. does not provide the required motivation to reduce toxicity in β -asarone by hydrogenation.

Hydrogenation of aromatic compounds and alkenes may be discussed in detail by March et al. However, the instant invention does not merely lie in a hydrogenation reaction of a substituent group present on an aromatic compound. The instant invention uses hydrogenation to address a vital issue of great economic importance which is the high level toxicity of the β -asarone in the Asian varieties. The novelty here is not just hydrogenation and its steps. In addition, there is no suggestion in either of these references that they can be combined and that there is a reasonable expectation of success.

Applicants submit that the present application is in condition for allowance and favorable consideration is respectfully requested.

Respectfully submitted

A handwritten signature in black ink, appearing to read 'Janet I. Cord', is written over a horizontal line. The signature is stylized with a large loop at the beginning and a long, sweeping underline that extends to the right.

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